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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,083	04/14/2004	Mikhail M. Feldstein	2335-0010	7175
23980	7590	11/28/2007		
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C 1400 PAGE MILL ROAD PALO ALTO, CA 94304-1124			EXAMINER CHEUNG, WILLIAM K	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			11/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/825,083

Applicant(s)

FELDSTEIN ET AL.

Examiner

William K. Cheung

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/13/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38,40,91 and 93-107 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38,40,91 and 93-107 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Request for Continued Examination

1. The request filed on September 13, 2007 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 10/825,083 is acceptable and a RCE has been established. An action on the RCE follows.
2. In view of the amendment of September 13, 2007, claims 1-37, 39, 41-90, 92 have been cancelled, and new claims 93-107 have been added. Claims 38, 40, 91, 93-107 are pending.

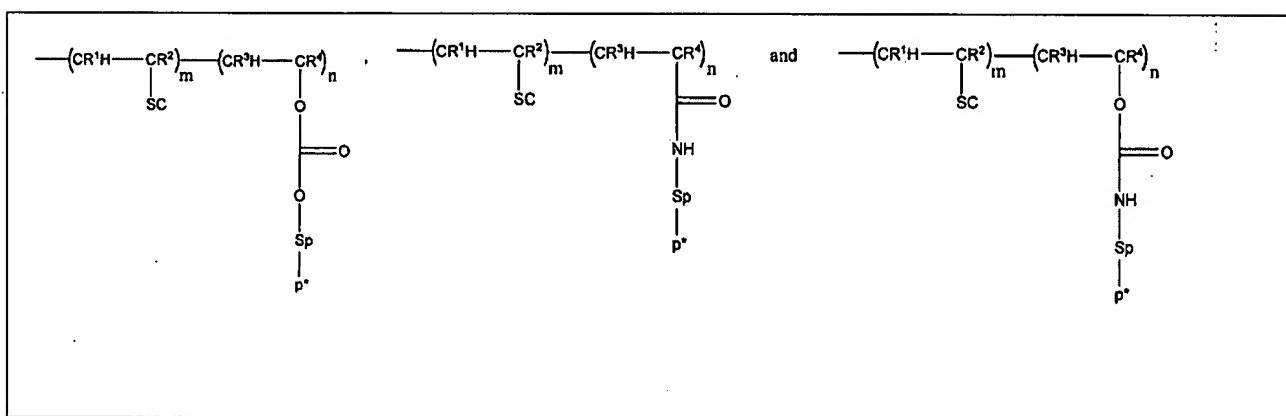
Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

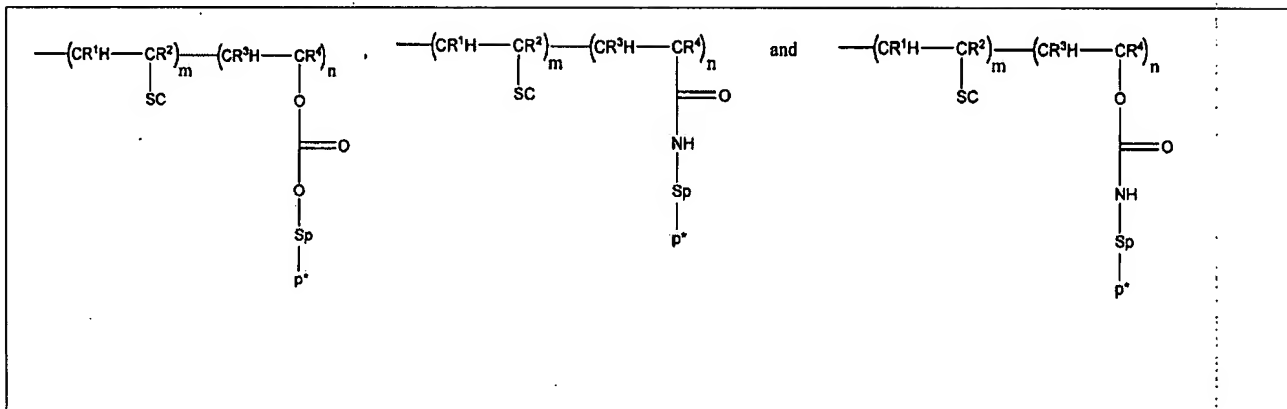
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 38, 40, 91, 93-94, 96-102, 104-107 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable

one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Throughout the entire specification, the examiner is unable to find adequate description to enable one of ordinary skill in art to make/or use the invention the copolymers of claims 38, 40, 91, 93-94, 96-102, 104-107 because the specification does not teach the preparation of the these claimed copolymers



5. Claims 38, 40, 91, 93-94, 96-102, 104-107 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Throughout the entire specification, the examiner is unable to find adequate description to enable one of ordinary skill in art to make/or use the invention the copolymers of claims 38, 40, 91, 93-94, 96-102, 104-107 because the specification does not teach the preparation of the these claimed copolymers



6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 38, 40, 91, 93-107 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

An improper use of MARKUSH GROUPS is recited in claim 38 (line 2-5). The term "are selected from and ..." is improper. It should be corrected to "are selected from a group consisting of, and" See MPEP 2173.05 (h).

An improper use of MARKUSH GROUPS is recited in claim 38 (line 8). The term "are selected from and ..." is improper. It should be corrected to "are selected from a group consisting of, and" See MPEP 2173.05 (h).

An improper use of MARKUSH GROUPS is recited in claim 91 (line 2-5). The term "are selected from and ..." is improper. It should be corrected to "are selected from a group consisting of, and" See MPEP 2173.05 (h).

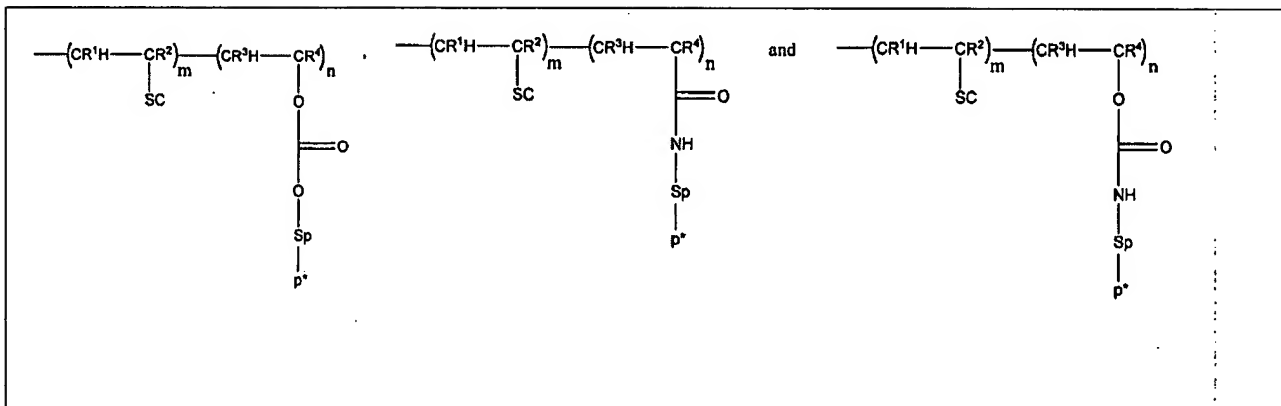
An improper use of MARKUSH GROUPS is recited in claim 91 (line 8). The term "are selected from and ..." is improper. It should be corrected to "are selected from a group consisting of, and" See MPEP 2173.05 (h).

An improper use of MARKUSH GROUPS is recited in claim 94 (line 2). The term "are selected from and ..." is improper. It should be corrected to "are selected from a group consisting of, and" See MPEP 2173.05 (h).

An improper use of MARKUSH GROUPS is recited in claim 102 (line 2). The term "are selected from and ..." is improper. It should be corrected to "are selected from a group consisting of, and" See MPEP 2173.05 (h).

Response to Arguments

8. Applicant's arguments filed September 13, 2007 have been fully considered but they are not persuasive. Applicants argue that the claimed are enabled in view of their similarity in hydrolysis properties. However, applicants fail to recognize that these argued structures as show below require different and complicated process to prepared as compared the enabled structure having L¹ as ~O-(CO)-.



Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K. Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



William K. Cheung, Ph. D.

Primary Examiner

November 23, 2007

WILLIAM K. CHEUNG
PRIMARY EXAMINER